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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,882	02/09/2001	Jacques Benkoski	MDS-P009	9016
35273 7590 04/12/2007 BEVER, HOFFMAN & HARMS, LLP 2099 GATEWAY PLACE SUITE 320 SAN JOSE, CA 95110			EXAMINER JANVIER, JEAN D	
			ART UNIT	PAPER NUMBER
			3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/780,882

Applicant(s)

BENKOSKI ET AL.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 26-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

Response To Applicant's Arguments

First, contrary to the Applicant's findings, the Office Action clearly points out the deficiency in the prior art. In fact, Robertson easily discloses the steps of using a CAD Tool and paying for the CAD Toll by a user via a portal (web site). Further, the Examiner admits that Robertson does not expressly teach providing a first payment and a second payment (one more payment) for the Tool (i.e. paying for the Tool based on a payment plan), wherein a request for the second (additional) payment is received when the user produces an output using the Tool and wherein the output bears a watermark (i.e. an identifier, a special font, a recognizable look, etc.) for identifying the output as having been produced by the Tool. However, it is common practice in the art to sell a product or service to a user and to allow the user to pay for the product or service by providing one or more additional payments over a certain period of time, after receiving an initial payment from the user, based on a payment installment plan (payment schedule). For example, a user, purchasing a vehicle from a dealer, a computer from a store or an expensive software package from a vendor/developer, agrees to pay the balance due in one or more subsequent payments, upon providing an initial payment from the user, in accordance with a payment installment plan (contract) negotiated between the user/buyer and the dealer, the store or the software developer. Additionally, it is common practice in the art to watermark an output or an object, such as a dollar bill or a Software or a video delivered to a user, to thereby verify or guarantee the integrity of the dollar bill, Software or the video while preventing fraud ("Official Notice").

Here, the examples cited in the "Official Notice" are easily identified in the art and need not be supported using any written document or concrete evidence. For instance, a dollar bill

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having a watermark printed thereon constitutes by itself a concrete evidence since a dollar bill is easily obtainable and thus, the presence of the watermark can be detected whenever one handles a dollar bill. Moreover, simply requesting a written document or concrete evidence in support of an "Official Notice" without pointing out the deficiencies recited therein, based on the state of the art and/or Applicant's understanding or background, is improper and hence, such a request will not be honored. In any event, the Examiner herein includes USP 6,650,761 to Rodriguez for featuring a video file or advertising having a watermark embedded therein. Additionally, the watermark, featured in the claims, is used for security purpose in a manner similar to that of the prior art. In the claims, the watermark helps secure the additional payments or balance due on the CAD Tool by making it easy to detect the presence of an output or file created using the CAD Tool, while preventing fraud, that is often associated with a contract or payment installment by making it difficult for an unscrupulous user to use the software or CAD Tool to produce one or more outputs and refusing to pay the additional payments. Having said that, contrary to the Applicant's conclusion, the "Official Notice" is proper for the materials or facts recited therein are well known in the art and capable of instant and unquestionable demonstration (MPEP 2144.03).

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the last Office Action, as shown below, is hereby maintained and the current **Office Action has been made Final**.

DETAILED ACTION

Specification

It appears that no drawing was filed along this Application.

The title of the invention should be descriptive and technically accurate. Furthermore, the abstract of the disclosure should be descriptive. See 37 CFR 1.72.

Status of the claim

Claims 26-40 are currently pending in the Application.

General Comments

Concerning claims 28 and 35, in the limitation "...the trigger condition disables a set of features of the CAD tool **until the additional payment is made**", it appears that the specification does not expressly support the above recitation.

Further, although the specification discloses, on page 6 [2], that well known techniques for regulating the usage of software, including licensing, password, time limits, usage counts (auditing), may be used by the CAD company, however, it is unclear how the software company can successfully use any of those techniques to secure additional payments once the software or CAD is installed on the user's computer and that the company does not have a computer or a monitoring system connected, over a communication link, to conduct a real-time surveillance, monitoring of the user's computer to detect whether the CAD or software was used in producing an output. To this end, the CAD company, as far as securing additional payments, is at the mercy of the CAD user or project designer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson, USP 6,594,799.

As per claims 26-40, Robertson discloses a multi-faceted portal site that acts as a server in the context of an n-tier client/server network and connects electronic designers and design teams to design and verification tool and service providers on the other through a single portal site. Tools and services accessible to users through the portal site include electronic design automation (EDA) software tools, electronic component information, electronic component databases of parts (or dynamic parts), computing and processing resources, virtual circuit blocks, design expert assistance, and integrated circuit fabrication (**providing a CAD Tool to a user via a network, where the user runs or executes the provided Tool on his computer system to produce an output or complete a project**). Such tools and services may be provided in whole or in part by suppliers (manufacturers) connected to the portal site. Users accessing the portal site are presented with options in a menu or other convenient format identifying the tools and services available and are able to more rapidly **complete circuit designs** by having access to a wide variety of tools and services in a single location. **The portal site may facilitate purchase, lease or other acquisition (which may include pay-per-use or pay by installment based on a**

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contract or agreement) of the tools and services offered through it. The portal site tracks the movements of users through the portal site in order to learn about the design preferences and design approaches of users individually and in the aggregate. Previous actions taken by a user and by similarly-situated users may be considered in determining which information is presented to the user or in what order to present information to the user, thereby providing contextually-driven access (See abstract; fig. 3-5 and 7-10; col. 1: 35-54; col. 2: 12-24; col. 2: 40-54; col. 4: 49-61; col. 4: 64 to col. 5: 28).

In general, the present system features electronic design tools and automation and more specifically methods and systems for facilitating electronic circuit and chip design using resources accessible over a distributed electronic network such as the Internet, The system is also adapted to allow users, such as design engineers, to use these tools without a large capital outlay in either software or hardware (a user of a design and verification tool does not need a huge up front cash to access or use the tool to produce an output-col. 1: 10-14; col. 4: 48-61).

In another embodiment, the portal site 104 connects end users 102 looking for information on virtual circuit blocks or IP cores, or interested in purchasing such, with suppliers 106 offering virtual circuit blocks or IP cores. The portal site 104 may facilitate the locating and acquisition of suitable virtual circuit blocks or IP cores by, for example, providing a catalog of available IP cores, information regarding the IP cores, and access to mechanisms for protecting IP cores from unauthorized user or copying (col. 7: 11-19).

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Further, in a next step 624 of fig. 6, a purchasing routine is preferably invoked during which the selected IP core (virtual block design or CAD Tool) is purchased (receiving a payment for the purchase of the Tool). In a following step 626, the selected and purchased IP core is delivered to the user, preferably in electronic format over the Internet 230. As a part of step 626, the portal site 204 preferably performs a protection function where the IP core is protected from piracy or unauthorized use by embedding each IP core transmitted via the portal site with a digital watermarking (One type of digital watermarking technique that may be used is disclose, for example, in copending U.S. patent application Ser. No. 09/514,695 filed concurrently herewith, and hereby incorporated by reference as if set forth fully herein). Alternatively, a digital watermark may simply comprise an embedded code (such as an encoded/encrypted identifier or set of identifiers or a non-functional data) physically included as part of the IP core software (col. 18: 41-58).

The present system further comprising means for transmitting an electronic invoice from said selected provider or supplier of the (CAD) tool or service to the user's system over a distributed electronic network and remitting a transaction fee from the provider to said portal site for facilitating the transaction, such as the receipt acquisition of the tool or IP core from the supplier to the user's system via the portal site over the Internet, and means for receiving payment for said electronic invoice from said user, means for deducting the transaction fee from said payment at said portal site and means for remitting the remainder of said payment to said selected provider of the tool (integrated circuit fabrication services- See claims 10 and 11 of the current reference).

Finally, it is herein understood that one skilled in the art, a software, a CAD (AutoCAD) or a spreadsheet user familiar with the software, the CAD or the spreadsheet can identify whether an output has been produced with the software, CAD or the spreadsheet based on a visual inspection because the output bears a special font, a special look that makes it possible to identify the output as having been produced using the software, CAD or the spreadsheet.

See col. 6: 4 to col. 7: 10; col. 16: 25 to col. 19: 15; figs 5 and 6

As per claims 26, 33, 34 and 40, although Robertson discloses providing by the user a payment for (accessing) the (CAD) Tool, such as the IP core, however, he does not expressly teach providing a first payment and a second payment (one more payment) for the Tool (i.e. paying for the Tool based on a payment plan), wherein a request for the second (additional) payment is received when the user produces an output using the Tool and wherein the output bears a watermark (i.e. an identifier, a special font, a recognizable look, etc.) for identifying the output as having been produced by the Tool.

However, it is common practice in the art to sell a product or service to a user and to allow the user to pay for the product or service by providing one or more additional payments over a certain period of time, after receiving an initial payment from the user, based on a payment installment plan (payment schedule). For example, a user, purchasing a vehicle from a dealer, a computer from a store or an expensive software package from a vendor/developer, agrees to pay the balance due in one or more subsequent payments, upon providing an initial payment from the user, in accordance with a payment installment plan (contract) negotiated between the user/buyer and the dealer, the store or the software developer.

Additionally, it is common practice in the art to watermark an output or an object, such as a dollar bill or a Software or a video delivered to a user, to thereby verify or guarantee the integrity of the dollar bill, Software or the video while preventing fraud.

“Official Notice”

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure (“Official Notice”) into the Robertson’s system so as to allow a user to access a CAD tool to produce an output, upon receiving an initial payment from the user, and to pay the balance due in one or more subsequent payments based upon a payment installment plan (contract) negotiated between the user and the CAD supplier through the portal site, wherein the output produced using the CAD bears a special signature/feature, trademark, appearance, special font, or special identifier or watermark identifying the output as one having been generated using the CAD, thereby enabling a user or an independent designer to have real-time access to the tools, such as CAD tools, he needs to complete a project without a large initial capital outlay or large up front payment (See col. 4: 48-61 of Robertson’s) by negotiating via the portal site a payment installment plan or payment schedule with the supplier of a CAD tool, wherein the payment plan permits the user to defer payment or to pay the balance due in one or more subsequent payments in accordance with the payment schedule (contract) and after the user has used the tool to generate an output, which provides him with some income or cash flow, while making it easy to detect the presence of an output or file created using the CAD Tool, by inserting an identifier or a watermark therein, and preventing fraud, that is often associated with a payment contract or payment installment, by making it difficult for an unscrupulous user to use the software or CAD Tool to create one or more outputs and refusing to

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pay the additional payments or balance due by denying the fact that the software was used in generating one or more outputs, which show that the user has been productive and has been making money using the CAD Tool or design software.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,141,653A to Conklin discloses a multivariate negotiations engine for iterative bargaining which enables a sponsor to create and administer a community between participants such as buyers and sellers having similar interests; allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms, request sample quantities, and track activity; allows a seller/participant to use remote authoring templates to create a complete Website for immediate integration and activation in the community, to evaluate proposed buyer orders and counteroffers, and to negotiate multiple variables such as prices, terms, conditions etc., iteratively with a buyer. The system provides secure databases, search engines, and other tools for use by the sponsor, which enable the sponsor to define the terms of community participation, establish standards, help promote the visibility of participating companies, monitor activity, collect fees, and promote successes. All this is done through a multivariate negotiations engine system operated at the system provider's Internet site, thus requiring no additional software at the sponsors', or participant sellers', or buyer's sites. This also allows buyers and sellers to use and negotiate payment options and methods that are accepted internationally. The system maintains internal

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databases that contain the history of all transactions in each community, so that sponsors, buyers and sellers may retrieve appropriate records to document each stage of interaction and negotiation. Documents are created by the system during the negotiation process.

USP 6,269,467B1 to Chang discloses a method and apparatus for designing a circuit system, including selecting a plurality of pre-designed circuit blocks to be used to design the circuit system, collecting data reflecting the experience of the designer regarding the pre-designed circuit blocks, the designer's experience being adaptable to a processing method, accepting or rejecting a design of the circuit system in a manner based on the designer's experience data and acceptable degree of risk, upon acceptance, forming block specifications containing criteria and modified constraints for each of the circuit blocks, upon acceptance, forming block specifications for deploying the circuit blocks on a floor plan of a chip, as a system on a chip, in compliance with the criteria and modified constraints, and substantially without changing the selected circuit block and the processing method (see abstract).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

04/09/07

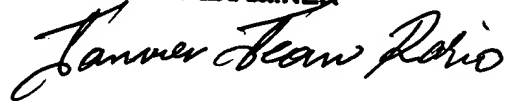
JDJ

Jean D. Janvier

Patent Examiner

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**JEAN D. JANVIER
PRIMARY EXAMINER**

A handwritten signature in black ink, reading "Janvier Jean D." in a cursive script.